

will be seen by those responsive arguments, this application is in condition for allowance because the posited combination fails to make a prima facie case of obviousness under section 103, at least for the reasons that the newly-cited reference relied upon does not include an uneven layer as recited at least in the independent claims, and there is no reason suggested in the newly-cited reference for making the proposed modification without the impermissible use of a hindsight analysis.

The Advisory Action was unclear on each of the foregoing points. First, the Advisory Action merely stated that the request for reconsideration has been considered. Presumably, this means that it is part of the record for appeal. If not, it should be since no further amendments were made to the pending claims after the final action.

Second, the Advisory Action says that the After Final Response fails to place the case in condition for allowance because “applicant presents new arguments that require further consideration”. Of course, there were new arguments presented in response to new grounds of rejection relying on a new reference; consideration should have been stated responsive to those arguments. Therefore, a response should have been provided to those “new arguments” so that the Applicant can better assess whether this appeal is necessary and/or desirable. On this record, and for the reasons stated above, and elaborated upon below, it appears that that the pending claims are patentable.

New Grounds of Rejection of Claims 1 to 10 based on a Newly-Cited Reference to Luecke and the Previously Cited Reference to Yamanobe

The examiner had contended that the Applicant’s amendment necessitated the new grounds of rejection. Previously, only the patent to Yamanobe et al. was relied upon and arguments advanced on why that patent does not teach or suggest an uneven shape of an uneven portion corresponding to the spherical aberration and the coma aberration of a wavefront. Now, the patent to Luecke is cited and principally relied upon for the finding stated at the bottom of page 2 of the Final Action.

In essence, in the Final Action, Luecke is said to show in Fig. 3 that a pair of substrates 70, 72 sandwich and seal a liquid crystal layer which controls a phase distribution of transmitted light 78, and a pair of electrodes apparently referring to electrodes 80 and 82, as generally described at col. 4, lines 20 to 34. A shape is described at col. 4, lines 35 to 50 as complementary to the wavefront aberration, but nothing is said about or suggested relative to providing another uneven portion. It may be noted that an uneven portion refers to the portion 111 shown in Figs. 3A and 3B.

Indeed, the examiner recognized that Luecke is deficient in teaching a separate layer to form the uneven surface and a pair of electrodes formed in planar shapes parallel to each other. He proposes, however, first to argue that it was well known to use planar electrodes and use a separate layer to form uneven surfaces to provide an even electric field. It is not fully clear where he supports that finding relative to the Luecke reference, but perhaps he is relying on the '681 patent for such a teaching rather than being "well known". In either case, however, the applicability of that finding to Luecke is not suggested by Luecke. See MPEP §2142

As understood, Luecke is self sufficient in teaching a compensator lens 48 as shown in Fig. 3. There is no reason found in Luecke or within the skill in the art to modify the embodiment of Fig. 3 to interpose a separate layer having the shape there shown. As specifically stated at col. 4, lines 35 to 40, the components are specified without any suggestion that an additional layer can or should be provided and have a sinusoidal shape to approximate the waves of aberration in the reflected wavefront measured from peak to valley. Moreover, it would seem from the discussion at col. 4, line 51 to col. 5, line 6 that minute distances are involved – on the order of nanometers – which would teach against additional layers in the laminate shown in Fig. 3. At the very least, the converse is not true – there is no teaching, hint or suggestion to modify Luecke as taught by the '581 reference even if such a combination were otherwise proper except for a motivation to do so.

The findings of fact supporting the reasons the modifications are obvious to one of skill in the art are conclusory.

The examiner, very helpfully it is submitted, stated findings as to claims 1 and 6, 3 and 9, and 10 as stated on pages 2 to 4. Those reasons are conclusory, lacking the specific findings of motivation to make the stated combination. It is thus submitted that the findings and conclusions of law are bottomed on an impermissible use of hindsight where, without the Applicant's template in the form of this application, no reason is present or argued to modify Luecke. See MPEP §2143.01

Respectfully, the reasons for making the combinations are conclusory, in the nature of wishes, not findings of fact, founded on the references or on the skill in the art. See, for example, the last sentence at the end of the paragraph concluding at the top of page 3 of the Final Action. Moreover, there is no support for the finding as to claims 3 and 9 or claim 10, and a specific reference is requested to support those findings, as permitted by the MPEP.

Claim 2 is not a product by process claim.

It was stated in the Final Action, relative to claim 2 where "said uneven portion is formed of a molded synthetic resins" is a product by process limitation. In this context, "formed" and "molded" are not used in the product by process sense, but rather to state that the material of which the molded synthetic resins is made. See MPEP §2113 where terms such as "welded", "intermixed", "press fitted" and others are held to be capable of construction as structural limitations.

The rejections of claims 9 and 10 are not factually supported

The rejections of claims 9 and 10 factually require a showing that a "uv curable resin" and a "photomask as an obvious variant of mold injection" in the claimed context. Since the finding was only advanced at the final action, the Applicant calls for support for each of these findings. See MPEP 2144.03, and especially 2144.03 (C) for challenging such finding.

Conclusion

Claims 1 to 10 are considered patentable over the art of record and the reasons advanced by the examiner for their rejection, and early Notice of Allowance is respectfully requested.

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Respectfully submitted,

By 

Ronald P. Kananen

Registration No.: 24,104

RADER, FISHMAN & GRAUER PLLC

1233 20th Street, N.W.

Suite 501

Washington, DC 20036

(202) 955-3750

Attorney for Applicant